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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John W. Rapp

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EXAMINER

HUISMAN, DAVID J

ART UNIT

PAPER NUMBER

2183

MAIL DATE

DELIVERY MODE

07/13/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/683,929	Applicant(s) RAPP ET AL.
	Examiner DAVID HUISMAN	Art Unit 2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16,41-50 and 66-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16,41-50 and 66-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/2011</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16, 41-50, and 66-85 have been examined.

Claim Objections

2. Claim 66 is objected to because of the following informalities: Applicant made the "to" amendment in the wrong place. Please replace "operable:", in line 4, with --operable to:--, and delete "to" from the beginning of each subsequent step. At the same time, please restore the rest of the claim to the point before the amendment made on May 3, 2011.
 3. Claim 73 is objected to because of the following minor informalities: In the 8th to last line, insert --to-- after "operable".
 4. Claim 78 is objected to because of the following minor informalities: In the 3rd to last line, insert --, to-- after "instruction".
 5. Claim 67 is objected for the same reason that claim 66 is objected to.
 6. Claim 74 is objected for the same reason that claim 73 is objected to.
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-16, 41-50, and 66-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

Art Unit: 2183

in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claim 1, the examiner asserts that the limitation “without using a virtual address” (and associated limitations) is new matter with respect to the original specification. The original specification (paragraphs [97]-[98]) merely sets forth an “address of the pipeline unit” or “an identifier that identifies the pipeline(s)”. This address can be rejected using any kind of address (virtual, physical, etc.). Applicant’s attempt to subsequently narrow the originally disclosed address to be a physical address, as argued, and not a virtual address is new matter.

The remaining independent claims are rejected for similar reasons.

All dependent claims are rejected for including new matter because they are dependent on claims including new matter.

It should be noted that if applicant deletes the new matter, to substantially return the claims to those filed on August 5, 2009, before the new matter was introduced, then the claims will be rejected under Inagaki, as modified, in substantially the same manner that the claims were rejected on October 5, 2009.

9. Claims 1-16, 41-50, and 66-85 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, without undue experimentation. With respect to claim 1, applicant first claims a message header having information indicating one but fewer than all of the processing pipelines (lines 5-7), and later claims generating, from the information, an identifier indicating the at least one processing

Art Unit: 2183

pipeline without using a virtual address (lines 12-13). Therefore, the examiner understands this portion of the claim as illustrated below:

Header info → Identifier → Pipeline(s)

In this situation, the header information is a virtual address because it is not a physical address of the pipeline, but instead information which is used to generate the physical address of the pipeline, i.e., the identifier. Hence, it is not clear how to make or use the claimed invention without using a virtual address when it appears that applicant is using a virtual address (Header info).

The remaining independent claims are rejected for similar reasons.

All dependent claims are rejected for lacking enablement because they are dependent on non-enabled claims.

Response to Arguments

10. Applicant's arguments filed on May 3, 2011, have been fully considered but they are not persuasive.

11. Applicant argues the rejection of claim 1 on pages 29-30, and in general states that network addresses, bus-port addresses (as disclosed in the specification in paragraph [84]), as well as pipeline identifiers/indicators, are physical addresses, and therefore, there is written description support for "without using a virtual address" in the claim.

Art Unit: 2183

12. Though fully considered, the examiner is not persuaded. The examiner does concede that a network address or bus-port address may be a physical address. But, that is not the issue. The issue is whether or not these types of broad addresses are always physical addresses. If these addresses cannot be limited to physical addresses, then they are broad enough to originally cover virtual addresses as well. Hence, to now limit them as only physical-type is new matter. Also, there is some confusion now as to what applicant's argued physical address is, as pages 29-30 of the arguments discuss network/bus-port addresses as being physical addresses, and also pipeline indicators/identifiers being related to physical addresses. However, these identifiers are separate from the network/bus-port addresses. It appears from claim 1 that applicant is trying to say that the identifier is a physical address and not a virtual address. Therefore, what does the bus-port and network address have to do with the identifier, which is separate?

13. Applicant argues the rejection of claim 1 on pages 30-31. Though fully considered, it is not clear how this argument proves that the examiner's rejection is incorrect. The issue, as stated in the above enablement rejection, is that applicant first claims a message header having information indicating one but fewer than all of the processing pipelines (lines 5-7), and later claims generating, from the information, an identifier indicating the at least one processing pipeline without using a virtual address (lines 12-13). Therefore, the examiner understands this portion of the claim as illustrated below:

Header info → Identifier → Pipeline(s)

Art Unit: 2183

14. That is, the header information does not directly point to a pipeline, but instead points to an identifier which points to a pipeline. In this situation, the header information is a virtual address because it is not a physical address of the pipeline, but instead information which is used to generate the physical address of the pipeline, i.e., the identifier. By definition, this is a virtual address. Hence, it is not clear how to make or use the claimed invention without using a virtual address when it appears that applicant is using a virtual address (Header info). It appears that applicant must clarify the claim such that it is clear what is actually being generated without using a virtual address. Because if the system generates a pipeline address from information, then that information is a virtual address.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2183

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID HUISMAN whose telephone number is (571)272-4168. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Chan can be reached on (571) 272-4162. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Huisman/
Primary Examiner, Art Unit 2183